



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,421	10/14/2004	Joseph Paternoster	298.41	4654
Richard A Nebb Dergosits & Noah Four Embarcadero Center Suite 1450 San Francisco, CA 94111				
7590 06/02/2008				
EXAMINER				
ROANE, AARON F				
ART UNIT		PAPER NUMBER		
3739				
MAIL DATE		DELIVERY MODE		
06/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/511,421

Applicant(s)

PATERNOSTER, JOSEPH

Examiner

AARON ROANE

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 6, 7 and 17-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5 and 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathewson (USPN 5,785,980) in view of Avera (USPN 4,865,640).

Regarding claims 1 and 11, Mathewson discloses a method of improving the physical performance of a user through thermoregulation comprising the steps of:

(a) applying a thermoregulating composition of matter to at least one portion of a user's body, wherein the cooling effect of this device is provided by the evaporation of water from the thermoregulating composition of matter and (b) performing physical exertion, see abstract, col. 2-7 and figures 1-5. Mathewson fails to disclose the thermoregulating composition of matter includes: cellulosic compound ranging from about 1% to about 3% by weight having an average molecular weight ranging between about 90,000 and about 700,000 represented by the formula: R-O-COOM, in which "M" is a metal substituted for hydrogen on

said carboxyl group of the cellulosic compound and "R" is cellulosic chain; a hydrated metallic salt ranging from about 0.1% to about 0.3% by weight, and water ranging from about 97% to about 99% by weight. Avera discloses a moisturizing agent and method and teaches using a substrate which gradually releases impregnated water and gas when interacting with a biological organism essentially comprising a mixture of: cellulosic compound ranging from 13% by weight having an average molecular weight ranging between 90,000 and 700,000 represented by the formula: $R-O-COOM$, in which "M" is a metal substituted for hydrogen on said carboxyl group of the cellulosic compound and "R" is cellulosic chain; a hydrated metallic salt ranging from 0.1-0.3% by weight; and water ranging from 97-99% by weight in order to provide moisture to biological organism, see abstract and claim 1. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Mathewson, as taught by Avera, to use a thermoregulating composition of matter includes cellulosic compound ranging from 13% by weight having an average molecular weight ranging between 90,000 and 700,000 represented by the formula: $R-O-COOM$, in which "M" is a metal substituted for hydrogen on said carboxyl group of the cellulosic compound and "R" is cellulosic chain; a hydrated metallic salt ranging from 0.1-0.3% by weight; and water ranging from 97-99% by weight in order to provide moisture to biological organism.

Regarding claim 5, Mathewson in view of Avera disclose the claimed invention except for explicitly reciting the thermoregulating composition of matter applied to the user ranges from about 0.2 to about 1 kilogram in weight. However, the examiner takes official notice the recited weight range as it is extremely well known in the art to provide a wide variety of garments have very pocket sizes and various numbers of pockets for holding the thermoregulating composition of matter.

Regarding claims 8-10, Mathewson in view of Avera disclose the claimed invention has the composition contains water and solids.

Regarding claims 12 and 13, Mathewson in view of Avera disclose the claimed invention, see Avera claim 3.

Regarding claim 14, Mathewson in view of Avera disclose the claimed invention, see Avera claim 4.

Regarding claim 15, Mathewson in view of Avera disclose the claimed invention, as water would not be able to get to the skin otherwise.

Regarding claim 15, Mathewson in view of Avera disclose the claimed invention, as Avera is directed at moisturizing.

Response to Amendment

The declarations filed on 2/8/2008 under 37 CFR 1.131 are sufficient to overcome the Klentrou I reference.

Response to Arguments

Applicant's arguments with respect to claims 1, 5 and 8-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON ROANE whose telephone number is (571)272-4771. The examiner can normally be reached on Monday-Friday 5:30AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/AARON ROANE/
Examiner, Art Unit 3739

/Roy D. Gibson/
Primary Examiner, Art Unit 3739